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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,690	04/21/1999	JEROME A MOUTON JR.	081862.P122	7482

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/295,690

Applicant(s)

MOUTON ET AL.

Examiner

JEAN B. FLEURANTIN

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-17 remain pending for examination.

Response to Applicant' Remarks

2. Applicant's arguments filed on 7 September 2004 with respect to claims 1-17 have been fully considered but, have been found persuasive to the extent that the prior art does not specifically disclose "chaining through intermediate versions". However, Moser discloses such limitations.

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking

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into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a method comprising" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "an apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "an apparatus comprising" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1, 9 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2.d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1, 9 and 12, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,148,329 issued to Meyer ("hereinafter 'Meyer'") in view of US Pat. No. 5,586,304 issued to Stupek, Jr. et al. ("hereinafter Stupek").

As per claim 5, Meyer discloses "an article comprising a computer readable medium having instructions stored thereon" as relates to the content and format of the messages stored in the folder and message database (see col. 4, lines 29-31) which when executed causes:

"receipt of an update message having a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version. Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format

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based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

As per claim 6, in addition to claim 1, Meyer further discloses "calling a next most recent version mapping function to map contents of the first update message to generate a second update message" (see col. 3, lines 6-14).

As per claim 7, Meyer discloses "wherein the update message includes a set of records for a database in the first version" (see col. 2, lines 60-64).

As per claims 8, Meyer discloses, "wherein the set of records for the database in the first version is a complete set of records for the database" as a means for existing messages will preferably be converted to the new format, the need for the conversion is automatically recognized by the message store (see col. 6, lines 52-54).

6. Claims 1-4 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,148,329 issued to Meyer ("hereinafter 'Meyer'") in view of US Pat. No. 5,586,304 issued to Stupek, Jr. et al. ("hereinafter Stupek") as applied to claims 5-8 above, and further in view of US Pat. 6,148,329 issued to Meyer ("hereinafter Meyer").

As per claim 1, Meyer discloses a method, wherein update comprises:

"receiving an update message having a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version. Meyer does not explicitly disclose repeatedly generating a revised update message having a next most recent version format based

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on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44). While, Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21). It would have been obvious to a person of ordinary in the art

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at time the invention was made to modify the combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended (see Moser col. 3, lines 32-36).

As per claims 2, 10 and 15, in addition to claim 1, Meyer further discloses "calling a next most recent version mapping function to map contents of the first update message to generate a second update message" (see col. 3, lines 6-14).

As per claims 3, 11 and 16, Meyer discloses "wherein the update message includes a set of records for a database in the first version" (see col. 2, lines 60-64).

As per claims 4, 12 and 17, Meyer discloses "wherein the set of records for the database in the first version is a complete set of records for the database" as a means for existing messages will preferably be converted to the new format, the need for the conversion is automatically recognized by the message store (see col. 6, lines 52-54).

As per claim 9, Meyer discloses "an apparatus comprising:
"means for receiving an update message having a first version format" as a means for redelivering the stored message is to update the format of the message to the current

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format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version. Meyer does not explicitly disclose a means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

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While, Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21). It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended (see Moser col. 3, lines 32-36).

As per claim 13, Meyer discloses an apparatus comprising:

"a network switching device to receive an update a message from a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is a being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version; and

"a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions" as a means for determining whether a stored message is formatted in accordance with a current message (see col. 2, lines 40-47). Meyer does not explicitly disclose the controller card repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

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As per claim 14, Meyer discloses "wherein the network switching device receives a first update message" as previously received messages in the database need to be updated to reflect the new and existing attribute definitions, message delivery addresses this need by providing a mechanism whereby the message store deletes the previously captured message attribute information and recreates it as if the messages were just being delivered for the first time (see figure 1, col. 4, lines 42-49).

CONTACT INFORMATION


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

December 21, 2004


SHAHID ALAM
PRIMARY EXAMINER